IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant	:	Hong Q. Bui
Appl. No.	:	09/457,839
Filed	:	December 9, 1999
For	:	SYSTEM AND METHODS FOR FACILITATING TRANSACTIONS ON, AND PERSONALIZING WEB PAGES OF, THIRD PARTY WEB SITES
Examiner	:	Cristina Sherr
Group Art Unit	:	3621

SECOND REPLY BRIEF

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This Second Reply Brief is responsive to the Examiner's Answer issued on June 26, 2007 (the "Examiner's Second Answer"). The Examiner's Second Answer is substantially identical to the original Examiner's Answer issued on April 10, 2007, except that (1) a missing page of the claim chart for Claim 36 has been added, and the claim chart has been moved to the end of the Answer, and (2) a section titled "Related Proceeding(s) Appendix" has been added at page 16. The arguments presented in this Second Reply Brief supplement those made in Appellant's Second Appeal Brief.

A renewed request for a telephonic oral hearing is being submitted with this Second Reply Brief.

1.   Rejection of Claims 36-39, 41, 42 and 66 under 35 U.S.C. § 103(a) over Foster

Claims 36-39, 41, 42 and 66 stand rejected on obviousness grounds over Foster (U.S. Patent 6,332,134, which claims priority to provisional application no. 60/162,651). As in the Examiner's Second Answer, references to "Foster" in the following discussion refer to the provisional application.

Independent Claim 36

In the Second Appeal Brief, Appellant argued that Foster does not teach or suggest the following limitations of Claim 36 in the context of the other limitations of the claim: "wherein the server system maintains a log of purchases made by the registered user from each of a plurality of merchant web sites, uses the log to generate an interests profile for the registered user, and disseminates the interests profile to the merchant web sites to allow the merchant web sites to provide personalized content to the registered user."

In connection with the claim language "the server system maintains a log of purchases made…from each of a plurality of merchants," the Examiner's Second Answer points to Foster's disclosure of a CardFort database that maintains a history of the consumer's CardFort purchases on the consumer's computer. See Examiner's Second Answer at page 5, under heading "First Issue," citing page 6, lines 5-7 of Foster. As explained in the Second Appeal Brief, however, nothing in Foster suggests that the consumer's computer acts as a server system as defined in the claim. In addition, nothing in Foster suggests moving the task of maintaining the log of purchases to such a server system. Thus, the cited portion of Foster does not teach or suggest a "server system [that] maintains a log of purchases made…from each of a plurality of merchants" in the context of Claim 36.

Regarding the claim language "uses the log to generate an interests profile for the registered user, and disseminates the interests profile to the merchant web sites to allow the merchant web sites to provide personalized content to the registered user," the Examiner's Second Answer points to the following excerpt of Foster:

> Because the transaction is tied to the CardFort ID number, the card company can enroll any cardholder in specific affinity or rewards programs. Processing savings and fraud reduction will allow more scope for rewards.

Examiner's Second Answer at page 5, under heading "First Issue," citing page 7, lines 25-28 of Foster. The cited excerpt, however, says nothing to suggest that the CardFort system either (1) uses a log of the cardholder's purchases to generate an interests profile for the cardholder, or (2) disseminates an interests profile for the cardholder to merchant web sites. In this regard, Foster says nothing to suggest that the affinity or reward programs are even operated by the merchants. In addition, even assuming *arguendo* that such a program were operated by one of the merchants, it is not clear why the task of enrolling a cardholder in this program would involve sending an interests profile for the cardholder to the merchant's web site. The Examiner's Second Answer does not address these issues.

The Examiner's Second Answer also points to Foster's statement that the CardFort database "serves as the launch pad for data to the card company." Examiner's Second Answer at page 6, lines 1 and 2, citing page 6, lines 17-18 of Foster. This statement apparently refers to the process by which product order information is initially stored on the consumer's computer (in the CardFort database), and is then transmitted to the card company's system. See Foster at page 3, lines 24-32. It is not clear how the Examiner's Second Answer is relying on this statement to support the rejection. Indeed, the statement does not teach or suggest the limitations at issue.

For at least the foregoing reasons, Foster does not teach or suggest all of the limitations of Claim 36.

Appellant acknowledges that each and every element of the claim need not be identically found in the cited art. See *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742; 82 USPQ2d 1385, 1397 (2007) (noting that "a person of ordinary skill is also a person of ordinary creativity, not an automaton"). In the present case, however, the Examiner's Second Answer does not identify any particular *reason* that would have prompted one of ordinary skill and creativity to modify Foster to arrive at the claimed invention. See *KSR* at 1731 (noting that "it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does.")

For the foregoing reasons, the Examiner has not established a prima facie case of obviousness with respect to Claim 36. The rejections of Claims 36-39 are therefore improper and should be reversed.

Independent Claim 41

In the Second Appeal Brief, Appellant argued that Foster does not teach or suggest the following limitation of Claim 41 in the context of the other limitations of the claim: "wherein the customer information of the registered user transmitted to the merchant web site system further includes an interests profile that reflects purchases made by the registered user from each of a plurality of online merchants, such that the merchant web site system may personalize web site content for the registered user."

In response, the Examiner's Second Answer points to the same portions of Foster discussed above. Examiner's Second Answer at page 6, under heading "second issue" (note that the analysis of Claim 41 is substantially identical to the analysis of Claim 36). As discussed above in connection with Claim 36, the cited portions of Foster do not teach or suggest the transmission of a user's interests profile to a merchant web site, let alone an interests profile that reflects purchases made by the user from each of a plurality of merchants. Foster simply does not teach or suggest this feature.

For these reasons, the Examiner has not established a prima facie case of obviousness with respect to Claim 41. The rejections of Claims 41, 42 and 66 are therefore improper.

2. Rejection of Claims 44, 45 and 67-69 over Boesch in view of Linehan

Claims 44, 45 and 67-69 stand rejected on obviousness grounds over Boesch (U.S. Patent No. 6,092,053) in view of Linehan (U.S. Patent No. 6,327,578). Claims 44 and 67 are independent.

Independent Claim 44

In the Second Appeal Brief, Appellant argued that the rejection of independent Claim 44 is improper because, among other reasons, Boesch and Linehan do not individually or collectively teach or suggest the following limitations of the claim:

> generating an interests profile that reflects said purchases made by the first
> user from the plurality of online merchants; and

transmitting the interests profile of the first user to a web site system of at least one online merchant to allow the online merchant to provide personalized web site content to the first user.

In response, the Examiner's Second Answer points to five different passages of Boesch. Examiner's Second Answer at pages 7 and 8, beginning under the heading "Third Issue." Each of these passages is reproduced and discussed below.

Abstract of Boesch: *"The system has a consumer data structure that stores purchasing information for registered consumers. The software is able to access the consumer data structure and enter the consumer's purchasing information during subsequent purchases."* The term "purchasing information" in this passage refers to consumer-supplied information that is used to complete purchase transactions. See Boesch at, e.g., column 5, line 30 to col. 6, line 19. Nothing in Boesch suggests that this "purchasing information" includes an interests profile that reflects purchases made from a plurality of online merchants as claimed. Indeed, the only examples of purchasing information given in Boesch are customer's name, billing address, shipping address, and credit card number. See Boesch at column 6, lines 3-7. Thus, the cited passage does not suggest either the generation of an interests profile that reflects purchases made from a plurality of online merchants, or the transmission of such an interests profile to a web site system of an online merchant.

Column 2, lines 52-54 of Boesch: *"A further object of the present invention is to allow consumer information to be provided to merchants using payment systems from various service providers."* This passage, as best understood by Appellant, refers to the ability of Boesch's Consumer Information System (CIS) to interoperate with the payment systems of a variety of different vendors or service providers, such that the merchants need not use any particular payment system. Again, nothing in this passage suggests either the generation of an interests profile that reflects purchases made from a plurality of online merchants, or the transmission of such an interests profile to a web site system of an online merchant.

Column 2, lines 55-61 of Boesch: *"A further object of the present invention is to use the architecture of the consumer information server to aid the consumer in distributing all manner of information, not just purchase/money information, to a variety of recipients when those*

recipients are to receive essentially the same information from one recipient to the next." Nothing in Boesch suggests that "all manner of information," as used in this passage, includes an interests profile that reflects purchases made from a plurality of online merchants. In addition, the Examiner's Second Answer does not explain how or why this passage would have prompted one skilled in the art to modify Boesch's system to arrive at the claimed feature. Thus, this passage does not support the Examiner's conclusion that Boesch and Linehan collectively suggest the above-quoted limitations of Claim 44.

Column 2, lines 62-65 of Boesch: *"A further object of the present invention is to provide a mechanism for direct marketing to consumer wallet holders immediately before, during, or after completion of a transaction using a wallet."* Nothing in Boesch suggests that this "mechanism for direct marketing" includes either the generation of an interests profile that reflects purchases made from a plurality of online merchants, or the transmission of such an interests profile to a web site system of an online merchant.

Column 4, lines 44-49 of Boesch: *"The CIS software can also associate a consumer with an identification code that can be presented to the merchant's computer, thus allowing the merchant to 'recognize' a consumer and provide customer-specific messages, displays, and offers."* Nothing in Boesch suggests that the "customer-specific messages, displays and offers" mentioned in this passage are or can be generated by the merchant's computer using an interests profile that reflects purchases made by the user from a plurality of online merchants. Thus, this passage does not suggest either the generation of such an interests profile, or the transmission of such an interests profile to the merchant's system.

In view of the foregoing, the five passages cited in the Examiner's Second Answer do not teach or suggest the above-quoted limitations of Claim 44.

Linehan does not overcome the foregoing deficiencies in Boesch, and the Examiner's Second Answer does not contend otherwise. In addition, the Examiner's Second Answer does not identify a reason that would have prompted one of ordinary skill and creativity to modify the combined system of Boesch and Linehan to arrive at the invention of Claim 44.

For at least the foregoing reasons and the reasons explained in the Second Appeal Brief, the Examiner has not established a prima facie case of obviousness with respect to Claim 44. The rejections of Claims 44 and 45 are therefore improper.

<u>Dependent Claim 45</u>

Claim 45 depends from Claim 44, and adds the following: "wherein the interests profile is transmitted to the web site system in response to use by the first user of the electronic wallet service to make a purchase from the web site system." In connection with this claim language, the Examiner's Second Answer points to the following passage of Boesch: "*The CIS software can tailor its communication with the consumer's computer in accordance with a profile created by the CIS software. The profile is based upon preferences chosen by the consumer or created by the CIS software based on the consumer's behavior, from preferences chosen by the merchant, by a branding party, or the like.*" Examiner's Second Answer at page 8, first full paragraph, citing column 4, lines 47-54 of Boesch.

This passage, however, merely refers to the communications that occur between the consumer/consumer computer and the consumer information server (CIS). It says nothing about the transmission of an interests profile to a web site system of an online merchant. Thus, the cited passage does not support the rejection of Claim 45.

<u>Independent Claim 67</u>

In the Second Appeal Brief, Appellant argued that Boesch and Linehan do not individually or collectively teach or suggest, in the context of the other limitations of Claim 67, the portion of the claim shown below in bold:

67. A method of personalizing a web page of a web site, the method comprising:
    sending a cookie to a computer of a user for storage thereon, wherein the cookie corresponds to a domain of a server that has access to at least a name of the user, said domain being different from a domain of the web site so that the cookie is not transmitted to the web site, and wherein the web page includes a reference to an object served by the server, such that when a browser retrieves the web page, the browser is caused to request the object from the server; and

when a browser running on the computer of the user retrieves the web page from the web site and sends a resulting request for the graphic to the server, responding to the request by at least: (a) using the cookie transmitted with the request to identify the name of the user, (b) incorporating the name of the user into an instance of the object, and (c) returning the instance of the object to the user computer for display within the web page.

As a preliminary matter, the term "graphic" in the bolded portion of the claim should be replaced with the term "object" to maintain consistency with the remainder of the claim. (Note that a graphic is one type of object.) If the claim is otherwise found allowable, Appellant intends to make this change by amendment.

In response to Appellant's argument, the Examiner points to five different passages in Boesch. Examiner's Second Answer at pages 8-10, beginning under the heading "Fourth Issue." Each passage is reproduced and addressed below.

Column 6, lines 61-65 of Boesch: *"In the preferred embodiment, the process starts with a consumer requesting a merchant's offer 200 from a merchant. In response to the consumer's request, the merchant's computer responds by sending a browser readable file and the merchant's offer to the consumer's computer 202. The consumer's browser processes the browser readable file and sends the merchant's offer and a message to the CIS 204."* According to the Examiner's Second Answer, this passage reveals that the merchant's web page causes the user's web browser to send a request for an object to the Consumer Information Server (CIS). Even assuming, *arguendo*, that this interpretation is accurate (which Appellant does not concede), nothing in Boesch suggests that the CIS responds to this request by performing the following combination of steps: "(a) using the cookie transmitted with the request to identify the name of the user, (b) incorporating the name of the user into an instance of the object, and (c) returning the instance of the object to the user computer for display within the web page."

Column 7, lines 14-17 of Boesch: *"The message sent from the consumer's browser to the CIS indicates whether the browser contains a browser identifier. In the preferred embodiment, the browser identifier is a cookie."* The Examiner's Second Answer apparently treats this passage as an indication that the browser of the user/consumer sends a cookie to the CIS with a request for an object. Even assuming, *arguendo*, that this reading is accurate (which Appellant

does not concede), nothing in Boesch suggests "(a) using the cookie ... to identify the name of the user, (b) incorporating the name of the user into an instance of the object, and (c) returning the instance of the object to the user computer for display within the web page."

Column 5, lines 35-42 of Boesch: *"In the preferred embodiment, CIS 140 comprises ... consumer data structure 146 which stores consumer information which can be used in future transactions, merchant data structure 148 which stores information pertaining to different merchants, consumer transaction log 150 which stores information pertaining to the transactions for registered consumers, and merchant transaction log 152 which stores information pertaining to transactions for registered and non-registered consumers."* Nothing in this passage suggests that the CIS responds to the message from the browser by performing steps (a)-(c) of the claim. It is not clear how the Examiner is relying on this passage.

Column 6, lines 35-45 of Boesch: *"Consumer data structure 146 stores label-value pairs relating to consumers, including consumer 100, that have completed the registration process with the operator of CIS 140. The label-value pairs in consumer data structure 146 represent information that is necessary, and may include information that is useful to complete a transaction. The purchasing information can include the customer's name, billing address, shipping address, and credit card number, however this information should not be construed as a limitation. The useful information can also include email, telephone numbers, facsimile numbers, and user preference data (regarding shipping address, shipping method, and related data), however this information should not be construed as a limitation."* While this passage may indicate that the CIS stores the names of registered users/consumers, nothing in this or any other portion of Boesch suggests that a user's name is incorporated into an instance of an object that is returned to the user computer for display in the web page. To the contrary, the user's name and other purchasing information is apparently stored by the CIS so that it can be communicated directly to a merchant when the user completes a purchase with the merchant. See Boesch at, e.g., column 3, lines 55-61.

Column 7, lines 18-27 of Boesch: *"The CIS software receives and processes the message to determine if the consumer's browser contains an identifier which identifies a consumer that matches a data entry in a file in the consumer data structure of the CIS 206. The*

CIS software determines whether a single user or multiple users have used the consumer's browser 208 by checking the consumer data structure. If the CIS software identifies more than one user, the CIS software will select a user based on a selection criteria generated by the operator of the CIS." This passage refers to the process by which the CIS uses a browser identifier, such as a cookie, to determine whether any consumer information is stored in association with the particular browser. As with the other cited portions of Boesch, nothing in this passage suggests that the CIS performs the particular combination of steps, (a)-(c), recited in the claim.

In view of the foregoing, Boesch does not teach or suggest at least the bolded limitations of Claim 67, and particularly the combination of steps (a)-(c).

Linehan does not overcome this deficiency in Boesch, and the Examiner's Second Answer does not contend otherwise. In addition, the Examiner's Second Answer does not identify any particular reason that would have prompted one of ordinary skill and creativity to modify Boesch and/or Linehan to arrive at the invention of Claim 67.

In view of the foregoing, the Examiner has not established a prima facie case of obviousness with respect to Claim 67. The rejections of Claims 67-69 are therefore improper.

3.   Rejection of Claims 46-52 and 60-64 over Katis

Claims 46-52 and 60-64, of which Claims 46 and 60 are independent, stand rejected on obviousness grounds over Katis.

<u>Independent Claim 46</u>

In the Second Appeal Brief, Appellant argued that the rejection of Claim 46 is improper because Katis does not teach or suggest the following steps in the context of the other limitations of the claim:

> providing, in a web page of the merchant web site and in conjunction with a description of a purchasable item, a reference to a graphic served by the information service server, such that when a browser running on the computer of the user retrieves the web page, the browser is caused to request the graphic from, and transmit the cookie to, the information service server; and
> at the information service server, in response to receiving the cookie and a request for the graphic from the computer of the user, returning to the computer of

the user a single-action purchase graphic indicating that the item may be purchased
with a single selection action, said single-action purchase graphic being selectable
by the user to purchase the item.

In response, the Examiner's Second Answer points to two passages of Katis (U.S. Patent
No. 6,601,761). Examiner's Second Answer at pages 11 and 12, under heading Fifth Issue. Each
passage is reproduced and discussed below.

Column 3, line 58 to column 4, line 4 of Katis: *"In order to make a payment using the
co-branded electronic payment platform for an embodiment of the present invention, the user
invokes the co-branded electronic wallet application, and a co-branded electronic wallet window
is displayed for the user by the wallet server. The user enters a selection to make the payment
with the user's payment information stored by the wallet server, and the wallet server
automatically sends the user's payment information to a merchant's website server for the user.
The payment information sent by the wallet serve includes, for example, the user's stored credit
card, debit card, checking, or savings account related information or the stored digital payment
tokens pre-allocated for the user from the user's credit card, debit card, checking, or savings
account."*

This passage fails to suggest many of the limitations at issue. For example, nothing in this
passage, or any other portion of Katis, suggests "providing, in a web page of the merchant web
site and in conjunction with a description of a purchasable item, a reference to a graphic served by
the information service server." In this regard, nowhere does Katis say that the wallet display is a
graphic. Katis' statements that "a co-branded electronic wallet window is displayed" and "the
user makes a selection," suggest that it is not.

As another example, this passage of Katis does not teach or suggest the following "when a
browser running on the computer of the user retrieves the web page, the browser is caused to
request the graphic." This is true even if, *arguendo*, the wallet display in the wallet window is
treated as the "graphic" recited in the claim. In this regard, when a browser in Katis loads a
merchant web page from which the wallet can be invoked, the page does not cause the browser to
retrieve the wallet display. Rather, the wallet display is apparently retrieved and displayed only if
the user "invokes the co-branded electronic wallet application."

In addition, nothing in this or any other portion of Katis suggests that the user's browser transmits a cookie to the wallet server when the user invokes the wallet application on the merchant site. Indeed, this apparently would not be necessary in Katis since the user's request to invoke the wallet application apparently passes through the merchant's server. See Katis at column 6, lines 11-15. Thus, the following limitations of Claim 46 are not met in the context of the claim: "the browser is caused to request the graphic from, and transmit the cookie to, the information service server."

Column 9, lines 25-35 of Katis: *"...when the consumer 2 invokes the co-branded electronic wallet, and the browser on the consumer's PC 4 opens up the window 14 and serves up the wallet outside the frame in which the consumer 2 is shopping, the consumer 2 is able to pay the merchant for the goods or services with the consumer's tokens stored in the electronic cash purse server 24 the co-branded electronic wallet. Instead of checking to confirm, for example, whether or not there is sufficient credit on the consumer's credit card account at the time of the transaction, it is done prior to the time of the transaction, and only the authenticity of the tokens is checked at the time of the purchase."*

This passage does not address or overcome any of the deficiencies noted above. The Examiner's Second Answer apparently relies on this passage in connection with the following limitations of Claim 46: "a single-action purchase graphic indicating that the item may be purchased with a single selection action, said single-action purchase graphic being selectable by the user to purchase the item." The passage does not, however, suggest such a single-action purchase graphic. In this regard, Katis is silent on the exact sequence of steps performed by the user to complete the purchase transaction using tokens. For example, there is no indication of whether the user has to confirm the transaction after requesting payment using tokens.

In view of the foregoing, Katis does not teach or suggest all of the limitations of Claim 46. In addition, the Examiner's Second Answer does not identify a reason that would have prompted one of ordinary skill in the art to modify Katis to arrive at the invention of Claim 46.

For at least these reasons, the Examiner has not established a prima facie case of obviousness with respect to Claim 46. The obviousness rejections of Claims 46-52 are therefore improper.

Independent Claim 60

Appellant argued in the Second Appeal Brief that Katis does not teach or suggest the following limitations of Claim 60 in the context of the other limitations of the claim:

> providing, within coding of the web page, a reference to a graphic served by the server, such that when a browser retrieves the web page, the browser is caused to request the graphic from the server; and
> when a browser running on the computer of the user retrieves the web page from the web site and sends a resulting request for the graphic to the server, responding to the request by at least: (a) using the cookie transmitted with the request to identify the name of the user, (b) incorporating the name of the user into an image, and (c) returning the image to the user computer for display within the web page.

The Examiner's Second Answer does not fully address the foregoing limitations, and especially those of the second subparagraph quoted above ("when a browser running…web page"). Indeed, Claim 60 is not discussed in the Examiner's Second Answer.

With respect to the first subparagraph quoted above ("providing…from the server"), as explained above in connection with Claim 46, Katis does not use such a reference or process to display the wallet. In this regard, when the user loads the relevant web page of the merchant web site, the browser is not caused to request the wallet display. Rather, the user apparently must invoke the wallet application. In addition, nothing in Katis suggests that the wallet display is a graphic.

With respect to the second subparagraph, nothing in the Katis suggests "incorporating the name of the user into an image," particularly in the context of the overall process in Claim 60. The portions of Katis (column 6, lines 37-40 and column 8, lines 46-56) cited by the Examiner's Second Answer in connection with dependent Claim 47 do not disclose or suggest this feature. In addition, even if, *arguendo*, Katis' wallet display is treated as the "image" recited in Claim 60, the limitation "returning the image to the user computer for display within the web page" still is not met. In this regard, as discussed above, the wallet is not displayed within the merchant's web page in Katis, but is displayed in a separate window.

In view of the foregoing, the Examiner has not established a prima facie case of obviousness with respect to Claim 60. The rejections of Claims 60-64 are therefore improper.

CONCLUSION

For the reasons set forth above, Appellant respectfully submits that the rejections of Claims 36-39, 41, 42, 44-52, 60-64 and 66-69 are improper, and requests that these rejections be reversed.

Respectfully submitted,

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